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*In re* Application of:

Burgio et al.

Serial No.: 10/626,142

Filed: July 24, 2003

Attorney Docket No.: 58359US003

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PETITION DECISION

This is in response to the petition filed by applicants under 37 CFR § 1.181(a) on May 7, 2009, to request designation of New Grounds of Rejection in the Examiner's Answer mailed March 9, 2009, pursuant to MPEP § 1207.03 (IV).

#### BACKGROUND

On June 6, 2008, the examiner mailed a final Office action setting a three month statutory limit for reply. At the time this Office action was mailed, claims 1-3, 5-17, 19-25, 27-32 34-43 and 45-80 were pending and rejected. In this final Office action, the examiner rejected claims 1-3, 5, 8-11, 14-17, 19, 22, 30-32, 34, 36-43, 45-64, and 69-80 under 35 U.S.C. 103(a) as being unpatentable over Mitra et al. in view of Majeti et al.; rejected claims 6, 7, 12, 13, 20, 21, 23-25, 27-29 and 65-68 under 35 U.S.C. 103(a) as being unpatentable over Mitra et al. in view of Majeti et al., the combination being taken in further view of Aasen et al.; and rejected claims 30-32, 34, 35, 37-43, 45, 50-52 and 60-68 under 35 U.S.C. 103(a) as being unpatentable over Rozzi et al. in view of Majeti et al.

On August 6, 2008, applicants filed an amendment after final requesting reconsideration and withdrawal of the rejections set forth in the final Office action of June 6, 2008.

On September 2, 2008, the examiner mailed an advisory action indicating the request for reconsideration has been considered but does not place the case in condition for allowance.

On September 8, 2008, a Notice of Appeal was filed.

On November 7, 2008, applicants filed an Appeal Brief, appealing to the Board of Appeals from the examiner regarding the examiner's final rejection of the claims.

On March 9, 2009, an Examiner's Answer was mailed by the examiner. In this Examiner's Answer, the examiner rejected claims 1-3, 5, 8-11, 14-17, 19, 22, 30-32, 34, 36-43, 45-48, and

69-80 under 35 U.S.C. 103(a) as being unpatentable over Mitra et al. in view of Majeti et al.; rejected claims 6, 7, 12, 13, 20, 21, 23-25, 27-29, 49 and 65-68 under 35 U.S.C. 103(a) as being unpatentable over Mitra et al. in view of Majeti et al., the combination being taken in further view of Aasen et al.; and rejected claims 30-32, 34, 35, 37-43, 45, 50-52 and 60-68 under 35 U.S.C. 103(a) as being unpatentable over Rozzi et al. in view of Majeti et al.

In response thereto, appellants filed this petition under 37 CFR § 1.181(a) on May 7, 2009, requesting the designation of New Grounds of Rejection in the Examiner's Answer mailed March 9, 2009, pursuant to MPEP § 1207.03 (IV).

## DISCUSSION

The petition and the file history have been carefully considered.

In the petition filed on May 7, 2009, appellants argue that the Examiner's Answer mailed on March 9, 2009 contained a new ground of rejection which was not appropriately identified by the examiner. Specifically, appellants' argue the Examiner added a heretofore uncited document in Section (8), Evidence Relied Upon (page 4 of the Examiner's Answer mailed March 9, 2009). The Examiner listed the "Carbonyl Compounds" document on a PTO-892 form attached to the Examiner's Answer mailed March 9, 2009, thus confirming that the document was newly cited. Appellants further note that the document was used to support the Examiner's arguments on page 9, lines 5-7 of the Examiner's Answer mailed March 9, 2009.

It is Appellants position, in view of the newly cited art relied upon by the Examiner, that each of the present rejections constitutes a New Ground of Rejection pursuant to M.P.E.P. §1207.03(III):

*A new prior art reference >applied or< cited for the first time in an examiner's answer generally will constitute a new ground of rejection. If the citation of a new prior art reference is necessary to support a rejection, it must be included in the statement of rejection, which would be considered to introduce a new ground of rejection. Even if the prior art reference is cited to support the rejection in a minor capacity, it should be positively included in the statement of rejection. In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n. 3 (CCPA 1970). \*\*>Where< a newly cited reference is added merely as evidence of the prior \*\* statement made by the examiner >as to what is "well-known" in the art which was challenged for the first time in the appeal brief<, the citation of the reference in the examiner's answer would not >ordinarily< constitute a new ground of rejection within the meaning of 37 CFR \*> 41.39(a)(2)< .*

Appellants also argue in the final Office action mailed June 6, 2008, the examiner listed claims 6-7, 12-13, 20-21, 23-25, 27-29, and 65-68 as rejected under 35 U.S.C. §103(a) as unpatentable

over Mitra et al. in view of Majeti et al., the combination being taken in further view of Aasen et al. The Examiner's Answer included claim 49 in this rejection. As such, Appellants are interpreting the inclusion of claim 49 as a New Ground of Rejection. However, as noted above, there was no indication in the Examiner's Answer that a New Ground of Rejection was (A) approved by a Technology Center (TC) Director or designee; and (13) prominently identified in the "Grounds of Rejection to be Reviewed on Appeal" section and the "Grounds of Rejection" section of the answer, as required under M.P.E.P. § 1207.03(I),

Finally, appellants argue, in the final Office Action mailed June 6, 2008, the examiner listed claims 30-32, 34-35, 37-43, 45, 50-52, and 60-68 as rejected under 35 U.S.C. § 103(a) as unpatentable over Rozzi et al. in view of Majeti et al. The Examiner's Answer included claims 69-80 in this rejection. As such, Appellants are interpreting the inclusion of each of claims 69-80 as a New Ground of Rejection. However, as noted above, there is no indication in the Examiner's Answer that a New Ground of Rejection was (A) approved by a Technology Center (TC) Director or designee; and (13) prominently identified in the "Grounds of Rejection to be Reviewed on Appeal" section and the "Grounds of Rejection" section of the answer, as required under M.P.E.P. § 1207.03(I).

Appellants' points on the above issues are well-taken. A detailed review of the rejection shows that the examiner did set forth a new reference. Consequently, appellants have not been provided a fair opportunity to carefully consider and respond to this new reference included in the Examiner's Answer. Also, the examiner's answer includes, for the first time, claim 49 in the rejection of Mitra et al. in view of Majeti et al. and claims 69-80 in the rejection of Rozzi et al. in view of Majeti et al. As such, appellants have not been provided a fair opportunity to carefully consider and respond to the inclusion of these new claims in the Examiner's Answer

It is thus decided that the Examiner's Answer of March 9, 2009 indeed introduced a new ground of rejection. A new ground of rejection is permissible in an Examiner's Answer; however, an Examiner's Answer containing a new ground of rejection must adhere to the provisions set forth in the MPEP concerning the placement of such new grounds of rejection in an Examiner's Answer (MPEP § 1207.03 I-III). Specifically, the new ground of rejection set forth by the examiner in the Examiner's Answer as identified herein may be permissible according to MPEP § 1207.03; however, the Examiner's Answer must 1) be approved by a Technology Center Director or designee, 2) specifically identify the new ground of rejection as a 'new ground of rejection,' and 3) provide applicants a two-month time period to reply to the new rejection set forth in the Examiner's answer (see MPEP § 1207.03 I for guidance).


Because the examiner set forth a new ground of rejection in the Examiner's Answer and because the examiner did not properly adhere to the requirements for setting forth a new ground of rejection in the Examiner's Answer as set forth above, the Examiner's Answer was improper and is hereby VACATED.

## DECISION

The petition is **GRANTED**.

This application will be forwarded to the examiner to either issue a corrected Examiner's Answer adhering to the provisions set forth in MPEP § 1207.03 I for introducing a new ground of rejection in an Examiner's Answer; by issuing a corrected Examiner's Answer omitting the new ground of rejection identified herein; or alternatively, to reopen prosecution to set forth said new ground of rejection.

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 703-872-9306.

  
Michael Wityshyn  
Director, Technology Center 1600